

well settled law that the motivation requisite for an obviousness determination must come from the prior art, not applicants' specification. See, *In re Dow Chem. v. American Cyanamid Co.*, 5 USPQ2d at 1350 (Fed. Cir. 1989). ("[t]here must be a reason or suggestion in the art for selecting the [methods] used, other than the knowledge learned from the applicant's disclosure").

The Office Action states at page 3 that because taxol and 4-desacetyl-4-methylcarbonate taxol have the same core structure, "the skilled artisan would expect these compounds to have similar properties." However, as Applicants have demonstrated, the specific taxane derivative of the present invention in combination with doxorubicin has a different cardiotoxic profile than that of Taxol or docetaxel in combination with doxorubicin, despite the core structure similarities. Therefore, the similarity in core structure is not necessarily indicative of therapeutic similarity.

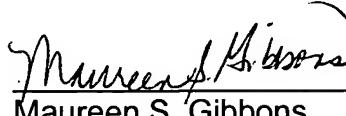
In the absence of evidence tending to show that one skilled in the art would have been motivated to select the specific taxane derivative that is described in the present invention, out of all the hundreds of taxane derivatives available, for combination with doxorubicin to provide methods for treating cancer that have improved safety profiles, a *prima facie* case of obvious is lacking. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicants believe that the present claims are in condition for allowance. An early Office Action to that effect is therefore, earnestly solicited.

Respectfully submitted,

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